UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,406	11/03/2000	James P. Tagg	SC-TAG-102	7866

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EXAMINER
BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
2442	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/706,406	TAGG, JAMES P.
	Examiner	Art Unit	
	DOUGLAS BLAIR	2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-45 and 48* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-45 and 48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 4/28/2011 has been entered.

Response to Amendment

The applicant's amended claim set includes claim 21 twice. The applicant's next response

should only feature claim 21 once.

Response to Arguments

Applicant's arguments filed 4/18/2011 have been fully considered but they are not

persuasive.

The applicant did not address the rejection of claims 21-45 and 48 based on 35 USC

section 112 1st paragraph that made in the 12/17/2010 office action. The rejection is maintained.

The applicant's arguments with respect to the rejection of claims 21-45 and 48 based on

35 USC section 103(a) as being unpatentable over Rai are not persuasive.

The applicant's arguments are not persuasive because the differences that the applicant is

implying are patentable over the prior art are not actually disclosed by the applicant. The

applicant is arguing that the prior art is only concerned with the security of the tunnel and not the

security of the host system providing the tunnel. If the applicant had disclosed some sort of security means for protecting the resources of a host system, the applicant might have had a point. Unfortunately, the applicant did not.

The applicant does not disclose any means for protecting the resources on the host system. The applicant's only disclosed manner of preventing is by designing client software which only creates the tunnel. Rai functions the exact same way as the applicant's disclosed invention. Rai provides software which is only used for creating a tunnel (col. 7, lines 39-67, the end user registration agent). So even if the applicant's disclosure could be relied upon to show written description support for the claimed subject matter, the applicant's disclosure does not put the public into possession of any subject matter that is not already disclosed by Rai. Therefore the applicant's invention is clearly not patentable.

The applicant's arguments about the Rai, Meier, and Tummala all fail to consider that the applicant does not disclose any subject matter that would put the public into possession of novel subject matter in exchange for patent protection. If the applicant disagrees with this assessment and wishes to further prosecution, the applicant needs to point out the exact location of embodiments which support the applicant's arguments for patentability.

Claim Objections

Claim 27 is objected to because of the following informalities: there are two articles before "virtual private network", "a" and "the". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-45 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's claims are rejected for two reasons under 35 USC section 112 1st paragraph.

First, the applicant's specification states the following:

Upon access by a mobile member, the CTA sends both identifiers and status information to a server. The server contains preference information on all members that can be referenced by their identifiers. The status information is compared to the preferences of the two members and, if the comparison is successful, a link to the Internet is provided to the mobile member.

In the applicant's disclosed invention, only when the host device supplies a proper identifier, is the link provided. Therefore the host device is authenticated to the target computer. The host device may not be supplying its own credentials but the claims are not that specific. The applicant's disclosure does not provide written description support for the claimed limitation of "a step of connecting the client system to the target network via a host system controlled by the software provided in the client system without needing to authenticate said host system to said target system".

Second, the applicant's specification does not provide support for the newly amended limitation of "wherein said client software is prevented from accessing resources outside of said

tunnel in said host system". The applicant's remarks from 4/18/2011 state that support for this

limitation can be found in at least paragraphs 27 and 28 of the applicant's specification. The

applicant's originally filed disclosure does not have paragraph numbers and has not been

published so it is not clear what paragraphs the applicant is referring to.

There is no disclosure of any form of "prevention" in the applicant's specification.

Instead the applicant disclosed client software that is designed in such a way that it does not

access resources of a host system. Though the applicant's client software does not access the

resources of the host system, the applicant has not disclosed any elements that explicitly prevent

the client from access resources at the host system.

Claim 27 is rejected because the applicant did not originally disclose that a host system

could be a VPN. This limitation first appeared in the amendment filed on 8/10/2005.

Claim 29 is rejected because the applicant's disclosure did not contain the concept of

comparing a cost to a predetermined limit. This limitation first appeared in the amendment filed

on 8/10/2005.

Claim 31 is rejected because the applicant's originally filed disclosure did not mention

channels which transmit time divided data. This limitation first appeared in the amendment filed

on 8/10/2005.

Claim 34 is rejected because the applicant's originally filed disclosure did not mention

notifying a user of the availability of a link wherein the user can accept or reject the connection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

Claims 21-45 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

As to claim 21, the applicant is reciting step plus function claims according to 35 USC

section 112 6th paragraph. The applicant's specification does not provide any algorithm tied to

the first step of "providing software". Software is provided in the applicant's disclosure but there

is not description of any step for providing it. Therefore it is impossible to determine the meets

and bounds of the applicant's claimed step of providing software. The applicant's claimed "step

of locating", "step of determining", and "step of linking" are unclear for the same rationale as the

"step of providing software".

The "step of determining" and "step of comparing" in claim 29, the "step of connecting"

in claim 32, the "steps of connecting", "step of comparing", "step of establishing", and "step of

disconnecting" in claim 32, the "step of converting" in claim 38, and the "step of ensuring" in

claim 48 are all rejected for the same reasoning as the step of "providing software" in claim 21.

Claim 34 recites the limitation "the establishing step". There is insufficient antecedent

basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 21-45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Number 6,377,982 to Rai.

As to claim 21, Rai teaches a method (as in exemplary claim 21) of connecting a client

system to a target network a step of providing software to the client system that will allow the

client system to connect to the target network (col. 7, line 39-43); and a step of connecting the

client system to the target network via a host system controlled by the software provided in the

client system (col. 7, line 39-43), the step of connecting the client system to the target network

comprising: a step of locating the target network through the host system (col. 8, lines 24-26); a

step of determining requirements for connecting the client system to the target network (col. 11,

lines 1-9); and a step of linking the client system to the target network based on the requirements

(col. 11, lines 1-9); wherein said client software is prevented from accessing resources outside

said tunnel in said host system (col. 7, lines 39-67, the end user registration agent is not disclosed

as having capabilities for accessing foreign agent resources); however Rai does not explicitly

state there is no need to authenticate the host system to the target system.

In Rai, the foreign service and home service already have an agreement in place. The

extra step of authenticating, as opposed to just identifying the foreign service from the request

received by the foreign service, would not be necessary.

It would have been obvious to one of ordinary skill in the Computer Networking art at the

time of the invention to combine the teachings of Rai regarding the use of a host system to locate

a home network with the idea of omitting the step of authenticating because according to the

MPEP section 2444.04, the omission of an element and its function is obvious if the function for

the element is not desired. In this case authenticating instead of just identifying the home

network would slow the process of providing access down.

As to claim 22, the foreign registration server is a server.

As to claim 23, see col. 4, line 66-col. 5, line 17.

As to claim 24, see col. 4, line 66-col. 5, line 17.

As to claim 25, see col. 5, lines 18-30.

As to claim 26, see col. 4, line 66-col. 5, line 17.

As to claim 27, see col. 4, line 66-col. 5, line 17.

As to claim 28, see col. 2, lines 33-35.

As to claim 29, see col. 6, lines 51-55.

As to claim 30, see col. 8, lines 24-26.

As to claim 31, see col. 5, lines 18-30.

As to claim 33, see col. 8, line 38-67.

As to claim 34, see col. 8, lines 24-26.

As to claim 35, see col. 24, lines 13-52.

As to claim 36, see col. 32, lines 31-60.

As to claim 38, the disclosed tunnel protocols from the foreign network to the home

network read on this limitation.

As to claim 40, see col. 4, line 66-col. 5, line 17.

As to claim 41, see col. 11, lines 10-20.

As to claim 44, see col. 8, line 38-67.

As to claim 45, see col. 5, lines 18-30, the disclosed protocols coordinate frequencies.

As to claim 48, Rai does not disclose that the client has an access to any part of the host so Rai satisfies claim 48 because there is no absence to the contrary.

As to claims 32, 37, 39, 42, and 43, the point of a patent is to provide legal protection of an idea in return for putting the public in possession of novel information regarding this idea. The subject matter of claims 32, 37, 39, 42, and 43 are not explicitly discussed by Rai. A careful review of the applicant's specification shows that the applicant's disclosure does not put the public into any details on how these claims would be implemented. In order to be enabled, the applicant's disclosure implies that those of ordinary skill would know how all of these limitations are implemented. Therefore Official Notice is taken that these claims would be obvious in the context of the claimed invention. Should the applicant disagree with this characterization, the Examiner implores the applicant to point where in the applicant's specification the novelty is disclosed regarding these claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/
Primary Examiner, Art Unit 2442